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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/965,003	09/27/2001	Rabindranath Dutta	AUS920010684US1	2730

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EXAMINER

TOMASZEWSKI, MICHAEL

ART UNIT

PAPER NUMBER

3626

DATE MAILED: 03/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/965,003	<b>Applicant(s)</b> DUTTA ET AL.	
	<b>Examiner</b> Mike Tomaszewski	<b>Art Unit</b> 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 September 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>16 October 2003</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Notice To Applicant***

1. This communication is in response to the application filed on 27 September 2001. Claims 1-19 are pending. The IDS statement filed on 16 October 2003 have been entered and considered.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 18 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(A) Claim 18 is unclear because it fails to recite which claim it depends from. Examiner will proceed as if Applicant intended claim 18 to depend from claim 17.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mayaud (5,845,255; hereinafter Mayaud), in view of Joao (6,283,761; hereinafter Joao).

(A) As per claim 1, Mayaud discloses a method comprising:

- (a) receiving a patient prescription for a specified medication (Mayaud: col. 27, lines 30-39);
- (b) verifying availability of insurance coverage from an insurance company for the patient prescription (Mayaud: col. 15, lines 48-53; col. 21, lines 33-41; col. 53, lines 23-34); and
- (c) verifying an insurance payment category for the prescription (Mayaud: col. 5, lines 33-43).

Mayaud, however, fails to expressly disclose a method comprising:

- (d) collecting the payment from the patient based on the payment category;  
and
- (e) transmitting the payment category and the payment to the insurance company excluding the medication information.

Nevertheless, these features are old and well known, as evidenced by Joao. In particular, Joao discloses a method comprising:

- (d) collecting the payment from the patient based on the payment category (Joao: col. 12, lines 18-43; col. 13, lines 7-20; col. 14, lines 59-67; col. 15, lines 1-5; col. 19, lines 12-21; col. 37, lines 47-65; Fig. 1); and
- (e) transmitting the payment category and the payment to the insurance company excluding the medication information (Joao: col. 12, lines 18-43; col. 13, lines 7-20; col. 14, lines 59-67; col. 15, lines 1-5; col. 19, lines 12-21; col. 37, lines 47-65; Fig. 1).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Joao with the teachings of Mayaud with the motivation of providing an apparatus and method for processing and/or providing healthcare

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information and/or healthcare-related information for facilitating a variety of healthcare applications (Joao: col. 8, lines 3-14).

(B) As per claim 2, Mayaud discloses the method of claim 1 wherein the payment category is a brand name (Mayaud: col. 4, lines 60-65).

Examiner has noted insofar as claim 2 recites, "selected from brand name, generic, and not covered," brand name has been recited.

(C) As per claim 3, Mayaud discloses the method of claim 1 further comprising dispensing the prescription to the patient (Mayaud: abstract; col. 4, lines 29-35).

(D) As per claim 4, Mayaud discloses the method of claim 1 further comprising collecting patient preexisting prescription information and patient insurance information from a storage medium (Mayaud: col. 15, lines 47-58; col. 21, lines 33-41; col. 41, lines 42-67; col. 42, lines 1-16; Fig. 12).

(E) As per claim 5, Mayaud fails to expressly disclose the method of claim 4 further comprising recording the prescription and the payment on the storage medium.

Nevertheless, these features are old and well known, as evidenced by Joao. In particular, Joao discloses the method of claim 4 further comprising recording the prescription and the payment on the storage medium (Joao: col. 16, lines 33-65; col. 17,

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lines 25-67; col. 18, lines 1-33; col. 19, lines 7-67; col. 20, lines 1-8; col. 37, lines 47-65; Fig. 1).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Joao with the teachings of Mayaud with the motivation of providing an apparatus and method for processing and/or providing healthcare information and/or healthcare-related information for facilitating a variety of healthcare applications (Joao: col. 8, lines 3-14).

(F) As per claim 6, Mayaud discloses the method of claim 1 further comprising checking for adverse reactions between the patient prescription and at least one preexisting patient prescription (Mayaud: col. 31, lines 18-67; col. 32, lines 1-21).

(G) As per claim 7, Mayaud discloses a method comprising:

- (a) storing patient prescription information on a storage medium (Mayaud: col. 41, lines 42-67; col. 42, lines 1-16; Fig. 16); and
- (b) providing unlimited access to the prescription information to the patient (Mayaud: col. 7, lines 30-45; col. 8, lines 60-63).

Mayaud, however, fails to expressly disclose a method comprising:

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- (c) providing limited access to the prescription information to third parties in response to authorization by the patient.

Nevertheless, this feature is old and well known in the art, as evidenced by Joao.

In particular, Joao discloses a method comprising:

- (c) providing limited access to the prescription information to third parties in response to authorization by the patient (Joao: col. 4, lines 6-11; col. 7, lines 16-19; col. 19, lines 7-12).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Joao with the teachings of Mayaud with the motivation of providing an apparatus and method for processing and/or providing healthcare information and/or healthcare-related information for facilitating a variety of healthcare applications (Joao: col. 8, lines 3-14).

- (H) Claim 8 differs from method claim 1 by reciting “a computer product in a computer readable medium” within its preamble. As per these elements, Mayaud’s patient information management system includes computers, databases, interfaces, and gateway-routers, among other components (Mayaud: col. 45, lines 7-67; col. 46, lines 1-67; col. 47, lines 1-10; Fig. 16). As such, it is readily apparent that Mayaud’s patient



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information management system is controlled by a computer product in a computer readable medium.”

The remainder of claim 8 substantially repeats the same limitations of method claim 1 and is therefore, rejected for the same reasons given above for claim 1, and incorporated herein.

(I) Claims 9-13 substantially repeat the same limitations of claims 2-6 and are therefore, rejected for the same reasons given for those claims.

(J) Claim 14 differs from method claim 1 by reciting hardware elements, namely, a receiving means, a first verifying means, a second verifying means, a collecting means, and a transmitting means. As per these elements, it is submitted that because the teachings of Mayaud and Joao disclose the process steps recited in method claim 1, claim 1, in order to perform the process steps, discloses the aforementioned hardware elements as well. As such, claim 14 substantially repeats the same limitations of method claim 1 and is therefore, rejected for the same reasons given above for claim 1 and incorporated herein.

(K) Claims 15-19 substantially repeat the same limitations of claims 2-6 and are therefore, rejected for the same reasons given for those claims.

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The cited but not applied art teaches a medication monitoring system and method (6,421,650); and a secure on-line authentication system for processing prescription drug fulfillment (US 2001/0047281).

The cited but not applied prior art also includes non-patent literature articles by Anonymous ("Healthy gains at Source Informatics" Dec 1996. Software Magazine. Vol. 16, Iss. 12. pg. S16.); Business Wire ("UCLA-Affiliate St. Mary Medical Center and Texas Cancer Center Partner as Beta Test Sites for Electronic Prescription Pad Service" Nov 5, 1999. pg. 1.); and Minicomputer News ("Prescription Tracker Eases Pharmacy's Mounting Workload" Jul 15, 1976. Vol. 2, Iss. 15. pg. 10.).

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mike Tomaszewski whose telephone number is (571)272-8117. The examiner can normally be reached on M-F 7:00 am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571)272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

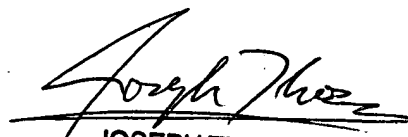
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MT



12.8.05



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